

# Notice of Allowability

Application No.

10/524,542

Examiner

Marc S. Zimmer

Applicant(s)

CHU, HSIEN-KUN

Art Unit

1712

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the telephone interview conducted on December 28, 2006.
2. ☒ The allowed claim(s) is/are 2-10, 14, 15, 17 and 18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

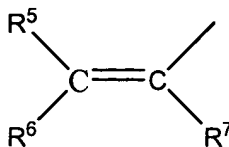
### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Steven Bauman on December 28, 2006.

Please replace all versions of claims 2, 4, 7-10, and 14 with the following:

2. The composition according to claim 15, wherein said curable composition is a dual cure photo/moisture curable composition.
4. The composition according to claim 15, wherein said curable composition is a moisture curable composition.
7. The composition according to claim 15, wherein X is O.
8. The composition according to claim 15, wherein R<sup>2</sup> is an alkoxy group having the formula R<sup>4</sup>O- wherein R<sup>4</sup> is a C<sub>1-2</sub> alkyl group.
9. The composition according to claim 15 wherein R is

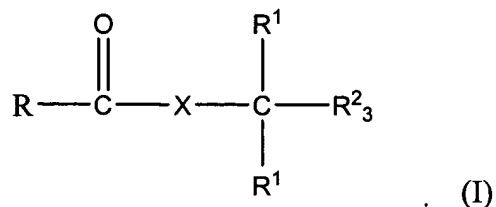


and R<sup>5</sup>, R<sup>6</sup>, and R<sup>7</sup> are independently selected from the group consisting of hydrogen, halogen, and organo radicals.

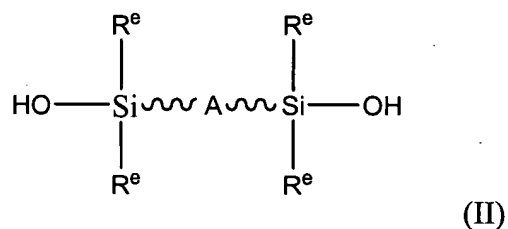
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10. A composition comprising

(a) a compound having the structural formula

wherein R is CH<sub>3</sub>, R<sup>1</sup> is hydrogen or a C<sub>1-6</sub> hydrocarbyl group, R<sup>2</sup> isOR<sup>4</sup>, R<sup>4</sup> is a C<sub>1-2</sub> alkyl group, and X is O, and

(b) a polymer having the structural formula



wherein A is a backbone selected from the group consisting of organic

and siloxane backbones, and R<sup>e</sup> is CH<sub>3</sub> or H.

14. The composition according to claim 15 wherein A is a polysiloxane.

Please change the dependency of claim 17 so that it is made dependent from claims 10 and 15.

Please cancel claims 12, 13, 16, and 19-20.

Applicant had contacted the Examiner to request clarification as to why the status of claims 5 and 6 had changed according to the advisory action mailed December 15, 2006. The Examiner explained that, insofar as *Scheim* was no longer considered especially germane in light of Applicant's amendments to independent claims 1, 16, and 19, claims 5 and 6, which had only been rejected over *Scheim*, were now placed into objected status as that reference had been withdrawn as a foundation for rejection. Applicant asked that these claims be made dependent from claims 10 and 15, which were indicated as allowable in an earlier stage or prosecution to place the case in condition for allowance. (The Examiner does not precisely recall Applicant's instructions to cancel the other claims but it was believed that their cancellation was understood to be necessary as they were still rejected over Sakamoto.)

Following the interview, the Examiner discovered while reviewing the case that it would be appropriate to revise claims 2, 4, 7-9, and 14 so as to make them dependent from claim 15 as they were all further limiting of this claim (though not of claim 10). Claims 17 and 18, likewise, were further limiting of both claim 10 and 15 hence claim 17 was amended to depend from these claims, this as opposed to canceling claims 17 and 18.

Claims 12 and 13 were not further limiting of either of claims 10 or 15 as there was no antecedent basis in the latter for the components disclosed in the former. The Examiner did not have Applicant's approval to add a new independent claim resembling claims 10 or 15 that also included mention of a cure system hence these claims have been canceled.

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Claim 10 is allowable over *Scheim* and *Sakamoto* because it requires that X is oxygen thereby overcoming the teachings of *Scheim* and requires R to be a methyl group thereby overcoming the teachings of *Sakamoto*. Claim 15 is allowable because it recites an exact ratio of alkoxy groups contributed by (I) to silanol groups contributed by (II). None of the references cited during this prosecution even outline a preferred range. Instead, one is left to estimate based on the relative amounts of materials advocated and the molecular weight/degree of polymerization of the polymer (which is necessary to know in order to calculate the number of moles of silanol groups). In the Examiner's estimation, this limitation is not fairly suggested by any of the references and, in fact, this limitation serves to severely narrow the scope of the claim. Lien, cited earlier, teaches a preferred ratio of *silane* to equivalent of silanol equal to 2.1 to 6.1. Each silane contributes three alkoxy groups hence the ratio of alkoxy groups to silanol groups would be 6.3:1 to 18.3:1.

No art more relevant than that already of record was discovered in an updated survey of the prior art. Accordingly, claims 2-10, 14-15, and 17-18 are deemed allowable.

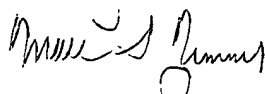
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 4, 2007



MARC S. ZIMMER  
PRIMARY EXAMINER